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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/663,963 09/19/00 ANDERSON

K M 6560 05/0A

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HM22/0418

EXAMINER

SRIVASTAVA, K

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

04/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/663,963

Applicant(s)

ANDERSON ET AL.

Examiner

Dr. Kailash C. Srivastava

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

1. Claims 1 -28 are pending.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I - Claims 1-12 drawn to a Culture Medium Composition, classified under Class 435, Subclass 253.6.

Group II - Claim 13 drawn to a Culture Medium Composition, classified under Class 435, Subclass 254.2.

Group III - Claims 14-28 drawn to a Process to make a polycarboxylic acid wherein a culture medium is applied to cultivate *C. tropicalis*, Classified under Class 435/69.9.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions in Groups I and II are related to each other as combination/ sub-combination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and (2) that the sub-combination has utility by itself or in other combinations [MPEP § 806.05(c)]. In the instant case, the combination does not require the particulars of the sub-combination as claimed for patentability because the combination, due to the presence of additional ingredients, would be patentable even if the sub-combination was known and non-obvious, assuming that the prior art does not teach or suggest the presence of the additional ingredients recited in the combination claims.

The sub-combination has utility of its own because of the presence of multiple ingredients (e.g. inorganic salts, a source of carbon and trace minerals). The literature review shows that the composition described in Claim encompassing Invention II is applicable to grow a variety of microorganisms, especially the ones that grow with xenobiotic substrates.

4. Inventions in Groups I and II are related to invention of Group III as products and application thereof. In this relationship, the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product [MPEP § 806.05(h)]. The compositions

claimed in invention encompassing Groups I and II have numerous materially different uses than the one claimed in invention described in Group III. A review of scientific literature on these compositions indicates that for e.g., the composition claimed in invention of Group I can be applied to cultivate any anaerobic bacterium. By the same token, the invention in Group II can be applied to cultivate any microorganism regardless of the fact that it produces a polycarboxylic acid. Similarly, a non-fermentative process without any microorganisms can also produce the polycarboxylic acid.

Because these inventions are **distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.**

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

The claims cover compositions comprised of mixtures of inorganic salts with a source of carbon and energy. The claims also cover method of using these compositions to produce a polycarboxylic acid.

6. Regardless of whichever one of Invention I-III are elected, the **applicant is required** under 35 U.S.C. 121 to **elect a single disclosed species of composition, enumerating all ingredients therein** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1, 13 and 14 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, **and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species [MPEP § 809.02(a)].

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. A telephone call was made to Mr. Steven J. Trzaska (applicant's representative) on April 4, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (703) 605-1196. The examiner can normally be reached on Monday to Thursday and every other Friday from 7:45 AM to 5:00 P.M (Eastern Daylight Saving, or Standard time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

K. C. Srivastava, Ph.D.
Patent Examiner
Art Unit 1651
(703) 605-1196

April 9, 2001



FRANCISCO PRATS
PRIMARY EXAMINER